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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/828,643	04/06/2001	Brian J. Roberts	3345-2240	5505
26875	7590	10/16/2003		
WOOD, HERRON & EVANS, LLP 2700 CAREW TOWER 441 VINE STREET CINCINNATI, OH 45202				
			EXAMINER CHERUBIN, YVESTE GILBERTE	
			ART UNIT 3713	PAPER NUMBER

DATE MAILED: 10/16/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/828,643

Applicant(s)

ROBERTS, BRIAN J.

Examiner

Yveste G. Cherubin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This action is in response to the Application No. 09/828,643 filed on April 6, 2001 in which claims 1-21 are pending. It is a continuation in part of US Application No. 09/060,423 filed on April 14, 1998.

### ***Claim Objections***

2. Claim 16 has been cited twice. The 2<sup>nd</sup> claim originally presented as claim 16 is being renumbered as claim 17. Accordingly, the following claims originally presented as claims 17-21 are also being renumbered as claims 18-22. The rest of the action will make reference to the new corrected claim numbers.

### ***Claim Rejections - 35 USC § 112***

3. a. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 15-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 15 and 16 recite the limitations "... adding an amount of money per ticket significantly less than the first -named prize pool; and". There is no support for this

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limitation in the specification. The Examiner urges the Applicant to point out in the specification where one can find support for this limitation.

Claim 19 recites the limitations "...identifying one of a plurality of specific games .....".

There is no support for this limitation in the specification. The Examiner urges the Applicant to point out in the specification where one can find support for this limitation.

b. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 16-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 16 recites " .... using said second prize pool to start said ....." There is insufficient antecedent basis for the term "second prize pool" . Appropriate correction is required.

Claim 17, recites " .... using said second prize pools to start said ....." There is insufficient antecedent basis for the term "second prize pool" . Appropriate correction is required.

Claim 17, further recites "...second prize pools ..." One notes that the word pools is in plural. The Examiner has no ideas as to what pools, the Applicant is referring to. Appropriate correction is required.

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Claim 18, recites the limitation "winning another game ..... holder is entitled to said other game". There is insufficient antecedent basis for this limitation in the claim.

Appropriate correction is required

Claim 18, further recites "said machine-readable information including ....." The Examiner notes that there is no consistency within the claim as to what type of readable information the Applicant is talking about. The term "machine-readable information" seems like a typographical error and needs to be amended to read "human-readable information ....."

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

a. Claims 1-3, 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haste, III (US Patent No.5,580,311) in view of Burr (US Patent No. 4,982,337 (of record)).

As per claims 1, 10, Haste teaches a pull-tab gaming machine for dispensing game tickets, see abstract, with each ticket including a machine-readable identifier uniquely identifying the ticket, 2:24-25. Haste further teaches a ticket supply, such as a continuous roll of tickets, installed in the machine together with an electronic memory module that contains a ticket record for each ticket in the supply. Among other data,

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each ticket record contains a deal number identifying a ticket "deal" where a deal is a database of winning and losing tickets. This last section is being read as having winning/losing code/identifier being stored in the electronic memory module corresponding to winning/losing tickets, keeping in mind that winning tickets always have prizes associated with them. Haste further teaches his device comprising a ticket reader for reading the identifier on each ticket before being dispensed and further include comparing means to compare the ticket identifier read from the memory module with the ticket identifier read by the ticket reader and if the ticket identifiers match, actuating the game ticket dispenser to dispense the ticket. Haste fails to disclose a plurality of distributed terminals and at least one central computer in communication with said terminals. Burr teaches a system and method for distributing lottery tickets including a large number of remote ticket-dispensing units connected to a central computer, see abstract and Fig 1. It would have been obvious to one ordinary skill in the art at the time the invention was made to improve upon the system taught by Haste by implementing the improvements detailed above because it would provide the system taught by Haste with the enhanced capability of reaching out to more players and allows provides better control for the system. As per claim 2, Burr teaches the remote ticket-dispensing units being connected intermittently via modem as shown in Fig 1, e.g. once each day or week to said central computer, see abstract, 3:1-17, 5:5-28. As per claim 3, having the terminals connected on-line would be an obvious matter of design choice. Doing so would allow a wide variety of players to take advantage of the gaming system. As per claims 10-11, they recite the limitations of claim 1 with the exception of the

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independent subsystems. Burr is cited to teach a very large number of remote units being employed in state-wide or nation-wide or city-wide lottery system where each state or city would have their own central unit, being read as subsystem, which in turn would be communicating with one central/supervisory computer unit, 3:1-17, 4:53-65.

b. Claims 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haste in view of Burr as applied to claims 1-3, 10-11 above, and further in view of Gerow (US Patent No. 5,944,606).

As per claim 4, Haste in view of Burr both teach tickets bearing indicia covered with a removable object to be removed to play a lottery game. However, they both fail to provide one ticket indicating that it is a jackpot winner. Gerow teaches a progressive pull-tab gaming system where one of the cards indicates that it is a jackpot winner, 3:61-62. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the jackpot card as taught by Gerow in the Haste in view of Burr type system in order to have a more attractive payout and therefore attract more players. As per claim 5, Gerow further teaches each dispensing unit comprising a display and communication means communicating ticket sales information to a control system and wherein said control system being programmed to add a predetermined increment to the amount of a jackpot prize until a match indication is given by the comparing means, said communication means being adapted for communicating said amount of said jackpot prize to said display means, 2:37-57, 6:47-51, 6:63-65, 7:16-18,

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42-58. As per claim 6, Gerow teaches that the dispensing unit could read or scan the card as it was dispensed thereby ensuring detection of the jackpot card, 7:15-18 and that the game could be stopped as soon as the jackpot card is dispensed, 6:63-65. Further below, in 7:8-10, Gerow teaches that the jackpot could be restarted after each jackpot card is redeemed and each new game being set with an initial predetermined jackpot value (which could be \$0 or 500), 7:8-11, 43-59. As per claim 7, Gerow teaches providing more than one jackpot pool, 7:8-11. As per claims 8-9, Burr teaches each dispensing unit having a printer to print out tickets/cards, 13:61-63, which include play information to determine the amount of any winning to the holder of the ticket.

c. Claims 12-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerow (US Patent No. 5,944,606) in view of Haste, III (US Patent No. 5,580,311).

As per claim 12, Gerow discloses storing a plurality of gaming tickets in each of a plurality of gaming ticket dispensers as shown in Fig 6, 6:3-5, providing a code reader associated with each of said dispensers for reading said coded information from each ticket dispensed from each dispenser, 2:1-6, 6:7, 6:31-37, detecting said information indicating that a given ticket is a winner, 6:511 and upon dispensing said ticket informing the recipient of said ticket that it is a winner, 8:40-43. Gerow further implicitly discloses each of said tickets bearing machine readable coded information identifying said ticket, 3:35-36, 4:50-60, however, Gerow is silent on whether the coded information on each ticket is unique. Haste is being cited to teach a device dispensing tickets, which are uniquely coded, see abstract, 2:56-58. It's obvious that this configuration would



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prevent duplicated tickets and facilitate tickets accounting. As per claims 13-14, they recite the limitations of claims 6 and 7 combined, therefore refer to the rejection of claims 6 and 7 above for rejection. As per claims 15-16, Gerow discloses having a plurality of jackpot prizes and starting a different pool after a present jackpot is redeemed, 7:8-11. Gerow further teaches the possibility of providing more than one jackpot, 7:8-11 and further teaches allowing the operator to control the parameters of the jackpot, 7:43-59, therefore it would have been a matter of design choice (up to the operator) to accumulate a second prize pool by adding an amount of money per ticket significantly less than the first named prize pool. This configuration would have encouraged players to participate in the first pool since it provides a larger payout. As per claim 17, Gerow discloses starting a different pool after a present jackpot is redeemed, 7:8-11 and Haste teaches a memory module that stores coded information. As per claim 18, Gerow teaches providing cards with serrated flaps that can be lifted to reveal underlying indicia of the value of the card, 3:24-27, 4:37-49.

d. Claims 19, 20, 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerow (US Patent No. 5,944,606) in view of Ford (US Patent No. 5,160,076 (of record)).

As per claim 19, Gerow discloses a progressive gaming method comprising the steps of: (a) providing a plurality of ticket dispensing machines; (b) using tickets having a removable cover over human-readable gaming information, 3:24-27, 4:37-49, each of said tickets also bearing machine-readable unique identification information, 4:50-60; (c)

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providing a jackpot prize pool which tickets are eligible to win, 1:48-56, 5:46-67; (d) providing a code reader in each of said dispensing means for reading said machine-readable identification information and producing corresponding signal, 2:1-6; 6:7-10, 31-37; (e) detecting said signals to identify a winner of said jackpot prize, 7:17-19. However, Gerow fails to disclose said machines dispensing instant-winner lottery tickets each having information identifying one of a plurality of specific games in which the ticket is issued. Ford teaches a ticket dispenser where each device dispenses a wide variety of tickets issued to specific games from a single unit. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the variety of tickets in one single unit as taught by Ford into the Gerow type device in order to attract different types of players. As per claim 20, it recites the limitations of claim 13, therefore to claim 1 above for rejection. As per claim 22, it recites the limitations of claim 12, therefore to claim 12 above for rejection.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gerow in view of Ford as applied to claims 19, 20, 22 above, and further in view of Weingardt (US Patent No. Re.35,864).

As per claim 21, Gerow in view of Ford substantially disclose the claimed invention as explained above. However, Gerow in view of Ford fail to disclose the step of accumulating a shadow pool by adding a second predetermined amount, smaller than the first-named amount , for each ticket dispensed by said dispensing machine. Wiengardt teaches a parimutuel electronic and live table gaming system which provides

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for seeding of the pools by the gaming establishment and for funding of future pools by setting aside into future pools portions of wagers made by current players, see abstract. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of pool shadow/seeding of Weingardt into Gerow in view of Ford type system in order to provide a more initial attractive pool at the beginning of the subsequent gaming session.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
  - a. US Patent No. 6,599,187 to Gerow, which teaches method and apparatus and gaming set for use in a progressive game.
  - b. US Patent No. 6,309,298 to Gerow, which teaches method and apparatus and game set for use in a progressive game.
  - c. US Patent No. 6,497,408 to Walker et al. which teaches system and method for conducting and playing a supplemental lottery game.
  - d. US Patent No. 5,186,463 to Marin et al., which teach method of playing lottery game.
  - e. US Patent No. 4,677,553 to Roberts et al., which teach secure placement of confidential information on a circulated blank ticket.
  - f. US Patent No. 5,772,510 to Roberts which teaches lottery ticket and system.

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yveste G. Cherubin whose telephone number is (703) 306-3027. The examiner can normally be reached on 9:30 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, T. Walberg can be reached on (703) 308-1327. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2159.

September 26, 2003

Ygc



Teresa Walberg  
Supervisory Patent Examiner  
Group 3700